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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,527	05/09/2001	Lydie Bougucleret	45.US2.PCT	8473

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EXAMINER

PAK, YONG D

ART UNIT PAPER NUMBER

1652

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/744,527

Applicant(s)

BOUGUELERET, LYDIE

Examiner

Yong D. Pak

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): rejection of claims 130, 132, 135 and 137 under 35 USC 102 (e).
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 128-132 and 134-1373.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

ADVISORY ACTION

Response to Arguments

The amendment filed on June 19, 2006 under 37 CFR 1.116 in reply to the final rejection has been considered and has been ENTERED but is not deemed to place the application in condition for allowance because: the amendment and request for consideration does not overcome the rejection of claims 21-36 and 41-44 under 35 U.S.C. 103(a) as being unpatentable over Wisnewski et al., Rys-Sikora et al. and Sato et al., as discussed below.

Claims 128-132 and 134-137 are pending and are under consideration.

Response to Arguments

Applicant's amendment and arguments filed on June 19, 2006, have been fully considered and are deemed to be persuasive to overcome the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Claim Rejections - 35 USC § 102/103

Claims 128-129, 131, 134 and 136 are rejected under 35 U.S.C. 102(e) as being anticipated by Greene et al.

In response to the previous Office Action, applicants have traversed the above rejection. Applicants argue that Greene et al. fail to teach the claimed polypeptide fragments, noting that the patent only refers to fragments of the polypeptides of Figure 1 (SEQ ID NO:2). Examiner respectfully disagrees. The claims are not only drawn to polypeptides consisting of fragments of SEQ ID NO:4, but the claims are also drawn to a polypeptide comprising a fragment of SEQ ID NO:4 (amino acids 200-300 of SEQ ID NO:4). Therefore, the full length of the hGGPS polypeptide depicted in Figure 3 anticipates the claimed invention.

Claims 128-137 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Greene et al. and/or Ping-Fan.

In response to the previous Office Action, applicants have traversed the above rejection.

Applicants argue that the hydrolysis of the protein of Greene et al. (SEQ ID NO:2) would not give rise to fragments of the instant claims because one skilled in the art would have only looked to the polypeptide of SEQ ID NO:2 in constructing such fragments given the emphasis placed on this polypeptide, SEQ ID NO:2, and not the hGGPS polypeptide depicted in Figure 3. Examiner respectfully disagrees. Greene et al. (WO 96/21736 and US Patent No. 5,786,193) both explicitly disclose that the hGGPS polypeptide depicted in Figure 3 is of the "present invention" (Column 3, lines 44-47 of US Patent No. 5,786,193 and page 6 of WO 96/21736). Therefore, one having

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ordinary skill in the art would have looked to both polypeptides (SEQ ID NO:2 and the hGGPS sequence depicted in Figure 3) to make enzymatically active fragments.

Hence the rejection is maintained.

None of the claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 571-272-0935. The examiner can normally be reached 6:30 A.M. to 5:00 P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Yong D. Pak
Patent Examiner 1652


Tekchand Saidha
Primary Patent Examiner 1652